

## REMARKS

### I. Summary of the Office Action

Claims 1, 2, 6-18, 35, 36, 40-48, and 61-62 are pending in this application.

Claims 1, 2, 6, 7, 9-11, 35, 36, 40, and 42-44 were rejected under 35 U.S.C. § 102(e) as being anticipated by Flickinger U.S. Publication No. 2005/0283796 ("Flickinger").

Claims 1, 2, 6-18, 35, 36, and 40-48 were rejected under 35 U.S.C. § 103(a) as being obvious from O'Connor et al. U.S. Patent Application No. 2005/0244138 ("O'Connor") in view of Zigmond et al. U.S. Patent No. 6,698,020 ("Zigmond").

### II. Summary of the Applicants' Reply

Independent claims 1 and 35 have been amended to more particularly define the claimed invention. Applicants have also added new claims 61 and 62. Support for amended claims 1 and 35 can be found at, for example, page 1, line 34 through page 2, line 7 of applicants' provisional Application No. 60/179,548 ("applicants' provisional application"). Support for new claims 61 and 62 can be found at, for example, page 2, lines 8-12 of applicants' provisional application.

The Examiner's rejections are respectfully traversed.

### III. Applicants' Reply to the § 102 Rejection

Claims 1, 2, 6, 7, 9-11, 35, 36, 40, and 42-44 were rejected under 35 U.S.C. § 102(e) as being anticipated by Flickinger. Amended independent claims 1 and 35 are fully supported by applicants' provisional application as filed on February 1, 2000. Flickinger's earliest filed provisional from which it claims priority is February 18, 2000. For at least this reason, applicants respectfully submit that Flickinger is not prior art to applicants' amended independent claims 1 and 35 under 35 U.S.C. § 102(e).

For at least this reason, amended independent claims 1 and 35 and dependent claims 2, 6, 7, 9-11, 35, 36, 40, and 42-44, which depend from either amended independent claim 1 or 35, are not anticipated by Flickinger. Accordingly, the Examiner's rejection should be withdrawn.

### III. Applicants' Reply to the § 103 Rejection

Claims 1, 2, 6-18, 35, 36, and 40-48 are rejected under 35 U.S.C. § 103(a) as being obvious from O'Connor in view of Zigmond. This rejection is respectfully traversed.

Applicants' independent claims 1 and 35 refer to a method and system for providing an integrated recorded

program/promotion playback asset. The program/promotion playback asset is a customized playback experience of recorded programming in that one or more promotions are insertably recorded with respect to the recorded programming such that during playback, the recorded promotion(s) appear as if they were originally part of the recorded programming. A selected program is received, and it is determined whether the selected program is to be recorded. In response to this determination, the selected program is recorded for inclusion in the integrated recorded program/promotion playback asset, and a promotion is selected and recorded for inclusion in the integrated recorded program/promotion playback asset. The recorded program/promotion playback asset is played back in response to receiving a user request to play back the recorded program.

It is well-established that "to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" (MPEP § 2143.03); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicants respectfully submit that the Examiner's § 103(a) rejection of independent claims 1 and 35 should be withdrawn at least because the Examiner's combination fails to disclose the

claimed feature of determining whether a selected program is to be recorded, and in response to determining that the selected program is to be recorded, recording a selected program and a selected promotion for inclusion in an integrated recorded program/promotion playback asset.

In applicants' independent claims 1 and 35, when it is determined that the selected program is to be recorded, a promotion is selected and recorded with it, creating an end result that, when watched, is plainly different than if the user had been watching the program on live television. Nowhere does the combination of O'Connor and Zigmund show or suggest performing this additional recording of a selected promotion with a selected program in response to a determination to record a selected program. In other words, nowhere does O'Connor or Zigmund show or suggest a causal link between selecting a program to record, and recording a selected promotion with the selected program. This causal link is not mere happenstance, but an integral feature of applicants' claims.

As indicated by the Examiner, O'Connor merely refers to recording a video stream that could include a program and commercials. To make up for the deficiencies of O'Connor, the

Examiner relies on Zigmond. Zigmond refers to a system that provides on-the-fly insertion of advertisements into a video programming stream at the household level. In addition, nowhere does Zigmond show or suggest the selection of a promotion to be recorded with a program in response to determining that a selected program is to be recorded. In fact, applicants' claims patentably improve upon Zigmond, as they provide a user with different promotions based on whether or not the program is being recorded. Thus, the combination of Zigmond and O'Connor fails to show or suggest this element of applicants' amended claims.

Moreover, Zigmond refers to a different approach for replacing advertisements in a recorded program with updated advertisements. Namely, Zigmond refers to replacing advertisements during the broadcast of a program while the user is watching that program. These advertisements are not insertably recorded with the program itself, but merely presented in the real-time programming feed. Thus, Zigmond teaches away from applicants' claimed approach, as presenting replacement advertisements in a real-time program feed results in a different end product than applicants' recorded program/promotion playback asset. Accordingly, even if

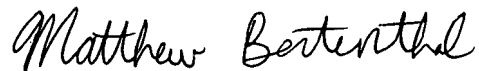
O'Connor could be modified to include the teachings of Zigmond, which it could not, the combination would still fail to show or suggest each limitation of applicants' independent claims 1 and 35.

Accordingly, for at least the foregoing reasons, amended independent claims 1 and 35 and dependent claims 2, 6-18, 36, and 40-48, which depend from either amended independent claim 1 or 35, are not obvious from O'Conner in view of Zigmond. This rejection should therefore be withdrawn.

V. Conclusion

In view of the foregoing, claims 1, 2, 6-18, 35, 36, 40-48, 60, and 61 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



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